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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/119, 209 07/20/98 LASKY

L 565D1C3

EXAMINER

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HM22/0129

PAK.M

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

01/29/01

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/119,209	Applicant(s) Laskey et al.
	Examiner Michael Pak	Group Art Unit 1646

Responsive to communication(s) filed on Oct 10, 2000

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 49-56 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 49-56 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 12

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10 October 2000 (Paper No. 11) has been entered.

***Response to Amendment***

2. The amendment filed 10 October 2000 (Paper No. 13) has been entered.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Outstanding rejection of claims 49-56 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 5,098,833 is withdrawn in view of applicants' arguments.

5. Applicant's arguments filed 10 October 2000 (Paper No. 13) have been fully considered but they are not found persuasive.

***Terminal Disclaimer***

6. The terminal disclaimer filed on 5 October 2000 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patent 5,840,844 has been indicated to be enclosed in the RCE transmittal letter but only the last page was enclosed. The terminal disclaimer could not be examined because of the missing pages.

***Double Patenting***

7. Claims 49-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,216,131. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to claims 1-16 of the issued U.S. Patent No. 5,216,131.

The terminal disclaimer indicated to be filed by the applicant in the RCE transmittal letter is missing a couple of pages critical for review and thus could not overcome the

rejection.

8. Claims 49-56 remains rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,840,844. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to claims 1-13 of the issued U.S. Patent No. 5,840,844.

The terminal disclaimer indicated to be filed by the applicant in the RCE transmittal letter is missing a couple of pages critical for review and thus could not overcome the rejection.

#### *Claim Rejections - 35 USC § 102*

9. Claims 49-51 and 54-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodruff et al. ((39); Ann. Rev. Immunol., 1987).

Woodruff et al. disclose the human lymphocyte homing receptor (pages 216-218)

The human lymphocyte homing receptor (hLHR) inherently has the same structure and sequence as the claimed sequence because the receptor was identified using the same technique as the mouse and rat and is isolated from the T-cells as are all other LHRs.

Applicants argue that the receptor of Woodruff et al. is not involved in lymphocyte homing to the HEV of mesenteric lymph nodes and thus is not lymphocyte homing receptor claimed. However, the references cited by applicants, Ley et al. and Watson et al. do not perform the same type of experiments with the same protein as Woodruff et al. and thus do not exclude the lymphocyte homing receptor in the Woodruff preparation.

Applicants argue Woodruff would not have enabled the ordinary skilled artisan to make the preparation of Woodruff. However, the claims do not exclude the preparation of Woodruff.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jalkanen et al. (IDS references 17-20) are cumulative reference with Woodruff et al. ((39); Ann. Rev. Immunol., 1987).

Applicants cite Bowen et al. which teach that comparison of Hermes sequence with the human pln receptor reveal no significant sequence homology. However, the generic claims are not directed to specific species of SEQ ID NO:2 and thus encompass the proteins of Jalkanen et al.

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is

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(703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*  
Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
26 January 2001